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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,264	09/19/2003	Ian Anthony Jones	Q90171	7763
23373 7590 12/05/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER ELVE, MARIA ALEXANDRA	
			ART UNIT 1793	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re application of
Ian Anthony JONES et al.
Serial No. 10/666,264
Filed: September 19, 2003
For: WELDING METHOD

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: DECISION ON
: PETITION
:
:

This is a decision on the REQUEST TO WITHDRAW FINALITY, mailed October 11, 2007.

On March 22, 2007, a non-final office action was mailed to applicants. A reply to the office action was filed on June 22, 2007. In the reply, applicants amended claim 1 to include limitation from claims 30-33 and claims 30-33 were canceled. On September 12, 2007 a final office action was mailed. The examiner stated in the office action that the new ground of rejection was necessitated by Applicant's amendments to the claims and the office action was made final. On October 11, 2007, the instant petition was filed.

Petitioner has argued that the finality of the office action mailed September 12, 2007 is improper. Petitioner argues that the rejection was improperly made final because it was not necessitated by Applicants' amendment. MPEP § 706.03(o) clearly states that any new matter added to a claim "must be considered as part of the claimed subject matter and cannot be ignored." Accordingly, the examiner was under an obligation to search the prior art for the subject matter of claims 31-33 before issuing the previous office action. Because the examiner did not present any prior art rejecting those claims, Applicants properly believed that amending the claims to incorporate claims 31-33 into independent claim 1 would overcome the cited prior art. Instead, the examiner cited additional prior art which newly addressed subject matter that was not newly added by Applicants' amendment.

DECISION

Section 706.07(a) of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Section 706.07(b) of the MPEP states:

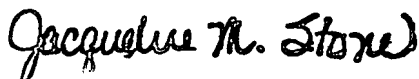
A second or any subsequent action on the merits in any application...should not be made final if it includes a rejection, on prior art of record, of any claim amended to include limitations which should reasonably have been expected to be claimed

The non-final office action of March 22, 2007 contained rejections under 35 USC 112, 35 USC 102 and 35 USC 103. Applicants amended claims in the response filed June 22, 2007. It is noted that claim 1 was amended to include limitations from claims 30-33 and claims 30-33 were cancelled. The addition of some of these limitations could have reasonably been expected since they were present in claims dependent on claim 1. However, the examiner could not have reasonably expected claim 1 to be amended to include the limitations of "the radiation absorbing material is selected from the group consisting of...

metal phthalocyanine dyes, metalized azo dyes and metalated indoaniline dyes". These limitations were not earlier presented. The above amendments could not have been reasonably expected to be claimed by the examiner upon issuance of the non-final rejection and thus do not preclude making the office action of September 12, 2007 a final rejection.

Further, petitioner states that the examiner cited the Kaieda reference in the final rejection to reject subject matter that was previously present in claim 31, but which was incorporated into independent claim 1 in Applicants' amendment. This is not found persuasive. The final rejection states "Kaieda et al. discloses the use of a resin and a phthalocyanine compound...". Claim 1 was amended in the response filed June 22, 2007 to include the limitations of "the radiation absorbing material is selected from the group consisting of cyanine dyes, squarylium dyes, croconium dyes, metal phthalocyanine dyes, metalized azo dyes and metalated indoaniline dyes". The Kaieda et al reference appears to have been cited by the examiner to teach the metal phthalocyanine dye added to claim 1, rather than the cyanine dye added to claim 1 from claim 31.

Accordingly, the finality of the September 12, 2007 office action was proper. The request to withdraw the finality is **DENIED**.



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